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Section II (Remarks)**A. Summary of Amendments**

By virtue of the present amendment, claims 1, 3-6, 8-11, 14, 16-24, 29 and 31 have been amended; claims 32-68 have been added; and claims 2, 7, 12, 13, 25, 26 and 28 have been cancelled, such that claims 1, 3-6, 8-11, 14-24, 27, and 29-68 are now pending in the application. No new matter within the meaning of 35 U.S.C. 132 has been added.

Claim 1 has been amended to include the limitations of prior claims 1, 2, and 12-13. The claim has been clarified to distinguish (1) an “audible signal” output by the at least one speaker from (2) an “audio signal” produced by the MP3 player.

Claim 3 has been amended to depend from claim 1, and to eliminate the ‘means-function’ language by substituting “retention element” for “means for retaining.”

Claim 4 has been amended to depend from claim 1, and to substitute “indicator element” for “indicator light.”

Claim 5 has been amended to refer to an indicator element (consistent with the amendment to claim 4).

Claim 6 has been amended to refer to an indicator element (consistent with the amendment to claim 4).

Claim 8 has been amended to depend from claim 1, to substitute “communicates” for “transmits” and to distinguish (1) an “audible signal” output by the at least one speaker from (2) an “audio signal” produced by the MP3 player.

Claim 9 has been amended to depend from claim 1, and to clarify that the coupling element is an electrical coupling element.

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Claim 10 has been amended to indicate that the term FireWire is trademarked, and to specify that the coupling element is any of a FireWire™ and an IEEE 1394-compliant coupling.

Claim 11 has been amended to depend from claim 1, to eliminate “means-function” language by substituting “coupling element” for “coupling means,” to substitute “output port” for “out port,” to substitute “at least one speaker” for “speaker” consistent with the recitation of the same claim 1, and to distinguish the “audible signal” produced by the at least one speaker from the “audio signal” produced by the MP3 player.

Claim 14 has been amended to depend from claim 1.

Claim 16 has been amended to eliminate “having an FM receiver for receiving radio frequency signals” in light of the incorporation of limitations from former claim 2 into amended claim 1.

Claim 17 has been amended to affirmatively recite an FM receiver, to include the limitations of former claims 25-26, to eliminate “means-function” language by substituting “communicating element” for “means for receiving,” and to distinguish (1) an “audible signal” output by the at least one speaker from (2) an “audio signal” produced by the MP3 player

Claim 18 has been amended to eliminate “means-function” language by substituting “retention element” for “retention means.”

Claim 19 has been amended to substitute “indicator element” for “indicator light.”

Claim 20 has been amended to refer to an indicator element (consistent with the amendment to claim 19).

Claim 21 has been amended to refer to an indicator element (consistent with the amendment to claim 19).

Claim 22 has been amended to eliminate “means-function” language by substituting “coupling element” for “coupling means.”

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Claim 23 has been amended to indicate that the term FireWire is trademarked, and to specify that the coupling element comprises any of a FireWire™ and an IEEE 1394-compliant coupling.

Claim 24 has been amended to eliminate “means-function” language by substituting “coupling element” for “means for connection,” to recite the communicating element of amended claim 17, to indicate that the amplifier is associated with the audio player, and to indicate at least one speaker consistent instead of merely “speaker” consistent with the language of claim 17.

Claim 29 has been amended to depend from claim 17, and to refer to the communicating element of amended claim 17.

Claim 31 has been amended to eliminate duplicative reference to the FM receiver, consistent with the affirmative recitation of the FM receiver in amended claim 17.

Claims 32-68 are newly presented and claim various features and combinations thereof provided in the present application.

The pending claims are amply supported by the text of the original disclosure and/or any of U.S. Patent Application No. 10/615,108 and U.S. Patent 6,591,085, both of which are expressly incorporated by reference into the present disclosure at page 5 of the present application.

The “digital frequency display” recited in new claims 34, 44, and 58 is disclosed, for example, in U.S. Patent Application No. 10/615,108 at Figure 19 and page 18, line 2 (i.e., “frequency indicator display 330, which in the drawing indicates a frequency of 102.5 megahertz (MHz).”).

The “portable digital media player” recited in new claims 52-68 is disclosed via the “MP3 player” recited through the application, which MP3 player provides a clear example of a portable digital media player.

The “storage medium” recited in new claims 39, 50, and 52 is disclosed, for example, at the third paragraph of page 2 of the present application.

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The “USB coupling” recited in new claims 40, 51, and 57 is disclosed, for example, at the third paragraph of page 7 of the present application.

The “IEEE-complaint coupling” recited in claims 10, 23, and 56, is disclosed, for example, by virtue of the repeated mention of the FireWire™ coupling, which is recognized in the art to be one variant of the IEEE 1394 standard. See, e.g., <http://en.wikipedia.org/wiki/Firewire>.

B. Allowable Subject Matter / Claim Objections

In the June 1, 2006 Office Action, claims 12, 13, 25, and 26 were objected to as being dependent upon a rejected base claim, but such claimed were indicated to be allowable if rewritten in independent form including all of the rejections of the base claim and any intervening claims. June 1, 2006 Office Action, page 6. Specifically, the examiner stated:

As to claims 12, 25, **the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency indicator on the main body portion** as specified in the claim.

As to claims 13, 26, **the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency tuning control on the main body portion** as specified in the claim.

June 1, 2006 Office Action, page 6.

In response to such objections, claim 1 has been amended to include all the limitations of (former, now cancelled) claims 2 and 12-13, *i.e.*, to recite that “the modular docking unit further comprises any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.” Similarly, claim 17 has been amended to include all the limitations of (former, now cancelled) claims 25-26, *i.e.*, to recite an “FM receiver with any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.” Consistent with the examiner’s indication that former (now cancelled) claims 12, 13, 25, and 26 were directed to allowable subject matter, amended claims 1 and 17 should be allowable.

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C. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

In the June 1, 2006 Office Action, claims 1-31 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, as to independent claims 1 and 17, the recitation "optionally, an FM receiver" was deemed to render the claims indefinite.

In response to this rejection, claims 1 and 17 have been amended to positively recite the FM receiver. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested.

D. Claim Rejections Under 35 U.S.C. § 102

In the June 1, 2006 Office Action, claims 1-3, 14, 17-18, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0114133 to Enners ("Enners").

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. v. Garlock*, 721, F.2d 1540, 220 USPQ 303 at 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough that the prior art reference disclose all the claimed elements in isolation. Rather, "**anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.**" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). Further, "[u]nder 35 U.S.C. § 102, anticipation requires that ... the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo, N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986).

Without squarely addressing the propriety of the rejections under 35 U.S.C. § 102(e) of original claims 1-3, 14, 17-18, and 27, and expressly reserving the right to prosecute the subject matter of any of such original claims in a continuing application, it is noted that claim 2 has been cancelled herewith, and **the remaining rejections are moot in application to the amended claims.**

Specifically, the Examiner has already conceded that:

"the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency indicator on the main body portion;"

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and

“the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency tuning control on the main body portion.”

Since the amended claims (*e.g.*, through independent claims 1 and 17) specifically require these features¹ not disclosed in the prior art, the prior art fails to disclose “each and every element of the claimed invention, arranged as in the claim” (*Lindemann, supra*) as required to support an anticipation rejection. Accordingly, withdrawal of the rejections of claims 1, 3, 14, 17-18, and 27 under 35 U.S.C. 102(c) is respectfully requested.

E. Claim Rejections Under 35 U.S.C. § 103

The June 1, 2006 Office Action contained various obviousness rejections under 35 U.S.C. § 103(a). Specifically:

- claims 4, 5, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Enners in view of U.S. Patent Publication No. 2002/0106993 to Shealtiel (“Shealtiel”);
- claims 6 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Enners in view of Shealtiel as applied to claims 4 and 19, and further in view of U.S. Patent Publication No. 2002/0086703 to Dimenstein (“Dimenstein”);
- claims 7-8, 16, 28-29, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Enners in view of U.S. Patent Publication No. 2002/0036357 to McGowan (“McGowan”);
- claims 9, 10, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Enners in view of Dimenstein; and
- claims 11, 15, 24 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Enners.

¹ *I.e.*, claim 1 requires that “the modular docking unit further comprises any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion, and claim 17 requires an “FM receiver with any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.”

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Concerning §103 obviousness rejections, three requirements must be met for a *prima facie* case of obviousness. First, **the prior art reference(s) must teach all of the limitations of the claims.** MPEP § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. MPEP § 2143.01. Third, a reasonable expectation of success is required. MPEP § 2143.02. In addition, the teaching or suggestion to combine and the expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP § 2143.

Without squarely addressing the propriety of the rejections under 35 U.S.C. § 103(a) of original claims 4-11, 15-16, 19-24, and 28-31, and expressly reserving the right to prosecute the subject matter of any of such original claims in a continuing application, it is noted that claims 7 and 28 has been cancelled herewith, and **the remaining rejections are moot in application to the amended claims.** Specifically, the Examiner has already conceded that:

“the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency indicator on the main body portion;”

and

“the applied references fail to disclose or render obvious that the modular docking unit comprises a frequency tuning control on the main body portion.”

Since the amended claims (*e.g.*, through independent claims 1 and 17) specifically require these features² not disclosed in the prior art, **the prior art fails to teach all of the limitations of the claims** as required by MPEP § 2143.03 to support a *prima facie* case of obviousness. Accordingly, withdrawal of the rejections of claims 4-6, 8-11, 15-16, 19-24, and 29-31 under 35 U.S.C. 103(a) is respectfully requested.

F. Patentability of New Claims 32-68

New claims 32-51 depend, whether directly or indirectly, on amended independent claims 1 or 17. As noted previously, claims 1 and 17 have been amended to include features already

² *I.e.*, claim 1 requires that “the modular docking unit further comprises any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion, and

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indicated to constitute allowable subject matter. Since dependent claims 32-51 inherently include all of the limitations of independent claims 1 or 17, claims 32-51 are patentable over the cited references for the same reasons expressed above with regard to claims 1 and 17.

New claims 52-68 include one independent claim, namely, claim 52, with the balance of claims depending (whether directly or indirectly) therefrom. Claim 52 recites:

52. An audio player adapted for use with a portable digital media player having a storage medium adapted to receive and store digital media files, the audio player comprising:
a main body portion having a docking cavity adapted to receive said portable digital media player, wherein the docking cavity includes therein an electrical coupling element adapted to engage the portable digital media player when the portable digital media player is received by the docking cavity;
an FM receiver having an associated frequency indicator disposed on the main body portion and a frequency tuning control disposed on the main body portion; and
at least one speaker associated with the main body portion and selectively operable with (1) the FM receiver, and (2) the portable digital media player when received by the docking cavity, to output audible signals.

Thus, claim 52 recites the “frequency indicator disposed on the main body portion” and “frequency tuning control disposed on the main body portion” already indicated to constitute allowable subject matter. The remaining limitations of claim 52 are similar to limitations already found in the preceding claims. Accordingly, claim 52 and dependent claims 53-68 are similarly believed to be allowable.

G. Excess Claim Fees

Claim fees corresponding to 2 independent claims and 31 total claims have been previously paid. By virtue of the present amendment, one independent claim and thirty-six dependent claims have been added, and seven dependent claims have been cancelled. Thus, a **net total of one (1) independent claim and (36 – 7 =) 29 dependent claims have been added**. Accordingly, excess claim fees calculated as $(1 \times \$100 + 29 \times \$25 =)$ **\$825.00** (small entity) are authorized in the enclosed Credit Card Payment Form PTO-2038.

claim 17 requires an “FM receiver with any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.”

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H. Consideration of Enclosed Information Disclosure Statement

Enclosed herewith is a Supplemental Information Disclosure Statement and accompanying copies of non-patent reference for consideration by the Examiner. Fee payment of **\$180.00** for the Supplemental IDS is authorized in the enclosed Credit Card Payment Form PTO-2038.

CONCLUSION

Claims 1, 3-6, 8-11, 14-24, 27, and 29-68 have been fully distinguished over the cited references, and are in form and condition for allowance. Issuance of a Notice of Allowance for the application is therefore requested. If any issues remain outstanding, incident to the formal allowance of the application, the Examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss and resolve such issues, so that that the application may be allowed and passed to issue.

Respectfully submitted,



Vincent K. Gustafson
Reg. No. 46,182
Attorney for Applicant

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
Phone: (919) 419-9350
Fax: (919) 419-9354
Attorney File No.: 4185-101-CIP2

Enclosures:

Information Disclosure Statement With Completed Form(s) PTO/SB/08 [4 pgs]
Copies of Non-Patent References Identified in Form(s) PTO/SB/08 [5 pgs]
Credit Card Payment Form PTO-2038 Authorizing \$1,005.00 [1 pg]

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